

11-8-04

JPW 3739

CERTIFICATE OF EXPRESS MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. §1.10 on the date indicated below and addressed to: Mail Stop IDS, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

11/5/04
Date

H. Kanzen
Signature

PATENT

Attorney Docket No. 39238-0747

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application)	<u>PATENT APPLICATION</u>
)	
Inventor(s): Roger A. Stern et al.)	
)	Art Unit: 3739
Application No.: 10/072,610)	
)	Examiner: Unassigned
Filed: February 6, 2002)	
)	
Title: HANDPIECE FOR TREATMENT OF TISSUE)	
)	

INFORMATION DISCLOSURE STATEMENT UNDER 37 C.F.R. §1.97

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Assignee is also the owner of related U.S. Patent No. 6,749,624 and has filed a lawsuit against Syneron Medical Ltd. and Syneron, Inc. on that patent in the United States District Court, Northern District of California, San Francisco Division, Case No. C-04-2995-CRB. Syneron has raised various defenses, including validity and enforceability defenses, to that action. Furthermore, the court conducted a preliminary injunction hearing in that case and issued an order denying the same. Various items related to the case and the preliminary injunction proceedings are submitted herewith as well as other information.

Further, Applicant submits herewith a copy of the electronic docket report from the court. Applicant will consider any request from the Examiner for any other papers mentioned therein.

Listed below or on an attached Form PTO-1449 is information known to applicant(s). A copy of each listed publication, other documents, and U.S. and foreign patent, except for pending U.S. applications, is being submitted herewith, along with a concise explanation of information in a foreign language, if any, pursuant to 37 C.F.R. §1.97-1.98.

Applicants respectfully request that the listed information be considered by the Examiner and be made of record in the above-identified application. If form PTO-1449 is enclosed, the Examiner is requested to initial and return it in accordance with MPEP §609.

This statement is not intended to represent that a search has been made or that the information cited in the statement is, or is considered to be, material to patentability as defined in §1.56.

☒ This statement qualifies under 37 C.F.R. §1.97, subsection (b) because (check all that apply):

- ☐ (1) It is being filed within 3 months of the application filing date and is other than a continued prosecution application under § 1.53(d)
-- OR --
- ☐ (2) It is being filed within 3 months of entry of a national stage
-- OR --
- ☒ (3) It is being filed before the mail date of the first Office Action on the merits
-- OR --
- ☐ (4) It is being filed before the mailing of a first Office Action after the filing of a request for continued examination under § 1.114.

☐ 37 C.F.R. §1.97(c). If this statement is being filed after the latest of: (1) three months beyond the filing date of a national application; (2) three months beyond the date of entry of the national stage as set forth in §1.491 in an international application; or (3) the mailing date of a first Office action on the merits, but before the mailing date of the earlier of a final office action under §1.113 or a notice of allowance under §1.311, then:

- ☐ a certification as specified in §1.97(e) is provided below; **or**
- ☐ a fee of \$180.00 as set forth in §1.17(p) is authorized below, enclosed, or included with the payment of other papers filed together with this statement.

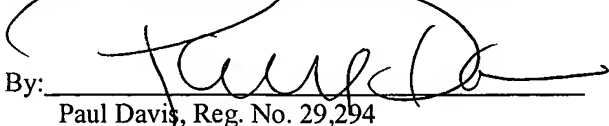
☐ 37 C.F.R. §1.97(d). If this statement is being filed after the mailing date of the earlier of a final office action under §1.113 or a notice of allowance under §1.311, but before payment of the issue fee, then:

- A. a certification as specified in §1.97(e) is completed below; and
- B. a petition under 37 C.F.R. §1.97(d) requesting consideration of this statement is submitted herewith; **and**
- C. a fee of \$130.00 as set forth in §1.17(i)(1) is authorized below, enclosed, or included with the payment of other papers filed together with this statement.

☒ **Fee Authorization.** The Commissioner is hereby authorized to charge the above-referenced fees of \$0.00 and charge any additional fees or credit any overpayment associated with this communication to **Deposit Account No. 08-1641 (Docket No. 39238-0747).**

Respectfully submitted,

HELLER EHRMAN WHITE & MCAULIFFE LLP

By: 
Paul Davis, Reg. No. 29,294

Dated: 11/5/04

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Menlo Park, CA 94025-3506
(650) 324-7000
Customer No. 25213



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			APPLICANT STERN, Roger A. et al.				
			FILING DATE 02/06/2002		GROUP: 3739		
U.S. PATENT DOCUMENTS							
EXAMINER'S INITIALS	PATENT NO.	DATE	NAME	CLASS	SUBCLASS	FILING DATE	
	6,053,909	4/25/00	Shaddock	606	3	3/27/98	
	6,413,253	7/2/02	Koop, et al.	606	27	11/3/98	
	5,509,916	4/23/96	Taylor	606	13	8/12/94	
	5,401,272	3/28/95	Perkins	606	15	2/16/94	
	5,011,483	4/30/91	Sleister	606	37	6/26/89	
	6,413,253	7/2/02	Koop et al.	606	27	11/3/98	
	6,273,885	8/14/01	Koop et al.	606	9	8/16/98	
	6,451,007	9/17/02	Koop et al.	606	9	7/29/99	
	5,344,418	9/06/94	Ghaffari	606	9	12/12/91	
	5,814,008	9/29/98	Chen et al.	604	21	7/29/96	
	5,968,034	10/19/99	Fullmer et al.	606	9	6/24/98	
	5,885,274	3/23/99	Fullmer et al.	606	9	6/24/97	
FOREIGN PATENT DOCUMENTS							
EXAMINER'S INITIALS	PATENT NO.	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
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	DE 10082526 T1	7/29/99	Germany			<input type="checkbox"/>	<input checked="" type="checkbox"/>
	WO 01/08545 A2	2/8/01	PCT	A61B		<input checked="" type="checkbox"/>	<input type="checkbox"/>
	WO 00/48644 A3	8/24/00	PCT	A61B	18/00	<input checked="" type="checkbox"/>	<input type="checkbox"/>
OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)							
	Thermage, Inc., "Complaint For Patent Infringement", July 23, 2004.						
	Thermage, Inc., "Motion for Preliminary Injunction", August 6, 2004.						
	Thermage, Inc., "Memorandum in Support of Motion for Preliminary Injunction", August 6, 2004.						
	Thermage, Inc., "Declaration of Edward A. Ebbers in Support of Motion for Preliminary Injunction" and attached exhibits A-E, August 6, 2004.						
EXAMINER			DATE CONSIDERED				

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.



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U.S. PATENT DOCUMENTS							
EXAMINER'S INITIALS	PATENT NO.	DATE	NAME	CLASS	SUBCLASS	FILING DATE	
	5,820,626	10/13/98	Baumgardner	606	13	7/30/96	
	5,814,040	9/29/98	Nelson et al.	606	9	5/15/95	
	5,595,568	1/27/97	Anderson et al.	606	9	2/1/95	
	5,735,844	4/7/98	Anderson et al.	606	9	4/7/98	
	6,659,999	12/9/03	Anderson et al.	606	9	6/5/00	
	5,979,454	11/9/99	Anvari et al.	128	898	6/6/97	
	6,171,301	1/9/01	Nelson et al.	606	9	11/3/97	
	5,628,744	5/13/97	Coleman et al.	606	12	12/21/93	
	5,683,380	11/4/97	Eckhouse et al.	606	19	3/29/95	
	5,810,801	11/22/98	Anderson et al.	606	9	2/5/97	
	5,885,273	3/23/99	Eckhouse et al.	606	9	2/9/96	
FOREIGN PATENT DOCUMENTS							
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OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)							
	Thermage, Inc. "Declaration of Dr. Maureen Reitman in Support of Motion for Preliminary Injunction" and attached Exhibits A-M, August 6, 2004.						
	Thermage, Inc. "Declaration of Dave B. Koo in Support of Motion for Preliminary Injunction" and attached Exhibits A-D, August 6, 2004.						
	Syneron Medical, Ltd., Syneron, Inc., "Declaration of Robert S. McArthur in Support of Syneron's Opposition to Plaintiff's Motion for a Preliminary Injunction" and attached Exhibits 1-25, August 17, 2004.						
	Syneron Medical, Ltd., Syneron, Inc., "Memorandum in Opposition to Plaintiff's Motion for a Preliminary Injunction", August 27, 2004.						
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	6,248,103	6/19/01	Tannenbaum et al.	606	9	5/28/99	
	5,906,609	5/25/99	Assa et al.	606	9	2/5/97	
	5,938,657	8/17/99	Assa et al.	606	9	2/5/97	
	5,964,749	10/12/99	Eckhouse et al.	606	9	9/15/95	
	6,050,990	4/18/00	Tankovich et al.	606	9	12/4/97	
	6,090,101	7/18/00	Quon et al.	606	9	12/10/97	
	6,104,959	8/15/00	Spertell	607	101	7/31/97	
	6,168,590	1/2/01	Neev	606	9	8/11/98	
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OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)							
	Syneron Medical, Ltd., Syneron, Inc., "Declaration of Dr. Warren S. Grundfest in Support of Syneron's Opposition to Plaintiff's Motion for a Preliminary Injunction" and attached Exhibits A-F, August 27, 2004.						
	Syneron Medical, Ltd., Syneron, Inc., "Declaration of Dr. Michael Kreindel in Support of Syneron's Opposition to Plaintiff's Motion for a Preliminary Injunction" and attached Exhibit A, August 27, 2004.						
	Syneron Medical, Ltd., Syneron, Inc., "Declaration of Domenic Serafino in Support of Syneron's Opposition to Plaintiff's Motion for a Preliminary Injunction" and attached Exhibits A-C, August 27, 2004.						
	Syneron Medical, Ltd., Syneron, Inc., "Declaration of Moshe Mizrahy in Support of Syneron's Opposition to Plaintiff's Motion for a Preliminary Injunction", August 17, 2004.						
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SHEET 4 OF 9

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EXAMINER'S INITIALS	PATENT NO.	DATE	NAME	CLASS	SUBCLASS	FILING DATE	
	6,210,402	4/3/01	Olsen et al.	606	32	11/25/97	
	6,235,024	5/22/01	Tu	606	41	6/21/99	
	6,337,998	1/8/02	Behl et al.	607	101	7/14/99	
	4,140,130	2/20/79	Storm, III	607	154	5/31/77	
	5,948,009	9/7/99	Tu	607	96	3/6/98	
	6,047,215	4/4/00	McClure et al.	607	101	3/6/98	
	6,273,884	8/14/01	Altshuler et al.	606	9	5/13/98	
	6,336,926	1/8/02	Goble	606	34	1/18/00	
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OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)							
	Syneron Medical, Ltd., Syneron, Inc., "Syneron Medical Ltd.'s and Syneron, Inc.'s Answer to Complaint with Jury Demand and Declaratory Judgment, Counterclaim against Thermage, Inc.", August 27, 2004.						
	Thermage, Inc., "Reply Memorandum re Motion for Preliminary Injunction", September 3, 2004.						
	Thermage, Inc., "Declaration of John M. Benassi in Support of Motion for Preliminary Injunction" and attached Exhibits A-B, September 3, 2004.						
	Thermage, Inc., "Declaration of Paul Davis in Support of Motion for Preliminary Injunction" and attached Exhibits A-C, September 3, 2004.						
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	6,500,141	12/31/02	Irion et al.	604	32	7/7/00	
	6,387,089	5/14/02	Kreindel et al.	606	9	5/10/99	
	5,964,749	10/12/99	Eckhouse et al.	606	9	9/15/95	
	5,405,368	10/20/92	Eckhouse et al.	607	88	10/20/92	
FOREIGN PATENT DOCUMENTS							
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OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)							
	Thermage, Inc., "Declaration of Robert Gerberich in Support of Motion for Preliminary Injunction", September 3, 2004.						
	Thermage, Inc., "Declaration of Edward W. Knowlton in Support of Motion for Preliminary Injunction", September 3, 2004.						
	Thermage, Inc., "Declaration of Richard J. Meader in Support of Motion for Preliminary Injunction", September 3, 2004.						
	Thermage, Inc., "Declaration of Maureen Reitman in Support of Motion for Preliminary Injunction (Supplemental)", September 3, 2004.						
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OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)							
	Syneron Medical, Ltd., Syneron, Inc., "Motion for Leave to File Syneron's Surreply in Opposition to Preliminary Injunction Motion", September 10, 2004.						
	Syneron Medical, Ltd., Syneron, Inc., "Surreply in Opposition to Thermage, Inc.'s Preliminary Injunction Motion", September 10, 2004.						
	Syneron Medical, Ltd., Syneron, Inc., "Supplemental Declaration of Jill Neiman in Opposition to Preliminary Injunction Motion" and attached Exhibits A-C, September 10, 2004.						
	Syneron Medical, Ltd., Syneron, Inc., "Supplemental Declaration of Warren Grundfest in Opposition to Preliminary Injunction Motion" and attached Exhibits A-B, September 10, 2004.						
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OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)							
	Judge Charles R. Breyer, "Order granting Motion for Leave to File Surreply", September 13, 2004.						
	Thermage, Inc., "Memorandum in Opposition re Motion for Preliminary Injunction to Syneron's Surreply", September 14, 2004.						
	Judge Charles R. Breyer, "Order Regarding Questions for Oral Argument", September 16, 2004.						
	Thermage, Inc., "Answer to CounterClaim", September 16, 2004.						
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	Themage, Inc., "Minute Entry: Motion Hearing held on 9/17/2004 before Judge Charles R. Breyer re Motion for Preliminary Injunction", September 17, 2004.						
	Judge Charles R. Breyer, "Order denying Motion for Preliminary Injunction", September 27, 2004.						
	Judge Charles R. Breyer, "Transcript of Proceedings held on 09/17/04", October 8, 2004.						
	Anvari et al., "Dynamic Epidermal Cooling in Conjunction with Laser Treatment of Port-Wine Stains: Theoretical and Preliminary Clinical Evaluations," Lasers in Medical Studies, 10: 105-112, 1995.						
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OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)							
	Anvari et al., "Spatially Selective Photocoagulation of Biological Tissues: Feasibility Study Utilizing Cryogen Spray Cooling," Applied Optics, Vol. 35, No. 19, July 1, 1996.						
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